

AUG 17 2006

Docket No.: 60097-0195

REMARKS/ARGUMENTS

## I STATUS OF CLAIMS

Claims 1-4, 14, and 16-29 remain in this application. Claims 1, 4, 14, 17, and 26 have been amended. Claim 15 has been cancelled.

## II CLAIM REJECTIONS – 35 U.S.C. § 103

The Office Action rejects Claims 1, 2 and 19-22 under 35 U.S.C. § 103(a) as being unpatentable over Gales Article: “Creatives find ‘Bookends’ a Solution to Viewer Apathy” (of record) in further view of Automotive News: “Audi Ads focus on technology” (of record) in further view of Geer et al. (U.S. 6,788,882 B1). The rejection is respectfully traversed.

Claims 1 and 2:

Claim 1 has been amended to clarify the claimed invention and appears as follows:

1. A process for enhancing the viewership of television advertisements in a digital video recorder (DVR) environment, comprising the steps of:
  - designating a beginning portion of a commercial break in a program segment;
  - wherein said beginning portion is of a particular length of time;

Docket No.: 60097-0195

wherein said beginning portion is authored to provide a teaser to entice a viewer to watch commercials during the commercial break before the viewer causes the DVR to skip through the commercial break; and wherein the DVR pauses playing the program segment after displaying the teaser.

As currently recited, Claim 1 cites that the DVR pauses playing the program segment after displaying the teaser. None of the cited references disclose a process wherein the DVR pauses playing the program segment after displaying the teaser.

Furthermore, the cited references fail to disclose a teaser to entice a viewer to watch commercials during the commercial break. The Office Action suggests that this feature is met in the Gales Article by “[t]he first half is followed by a separate, unrelated commercial so that the viewer has to wait for the second half to see what happens to the sufferer.” It is not clear how this constitutes “enticing a viewer to watch commercials during the commercial break.” Rather, the Gales article describes the function of a “first half is followed by a separate, unrelated commercial” as “involving viewers in an interactive way” so that “it gets them interested enough to stay with what is being presented longer.” However, “what is being presented” refers to the content of a single commercial as opposed to other commercials within the commercial break. It would have been counter-productive for an advertiser to entice viewers to watch other commercials within the commercial break, since other commercials might feature competing messages. In fact, the Larry Collins article: “. . . Media People See Pros and Cons,” paragraphs 6 and 7, appearing on the same page as the Gales Article, teaches that the bookending method disclosed in the Gales Articles actually has a negative effect upon

Docket No.: 60097-0195

other commercials in a commercial break. Thus, the Gales article fails to disclose authoring a beginning portion to provide a teaser to entice a viewer to watch commercials during the commercial break.

Therefore, the Gales Article in view of the Audi article in further view of Geer does not teach or disclose the invention as claimed.

Claim 1 is in allowable condition. Claim 2 is dependent upon independent Claim 1. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

Claims 19-22:

Claim 19 appears as follows:

19. A process for enhancing the viewership of television advertisements in a digital video recorder (DVR) environment, comprising the steps of:

receiving a commercial advertisement, the commercial advertisement is authored to provide a teaser in a first beginning portion of the commercial advertisement to entice a viewer to watch commercials during a commercial break before the viewer causes the DVR to skip through the commercial break; and

inserting the commercial advertisement as the first commercial in a commercial break in a program segment.

Docket No.: 60097-0195

As currently recited, Claim 19 cites that the commercial advertisement is authored to provide a teaser in a first beginning portion of the commercial advertisement. The Office Action states that the Gales article teaches this feature by citing that it is met by:

“‘[a]n example of bookend commercials is this Excedrin spot by DDB Needham/New York, left and right, in which the actor appears in the first 15-second pod stricken by a headache’ ‘and then the product’s benefit is shown in the second 15 seconds to signify it as being the solution to the actor’s headache’ (see Excedrin Commercial Spot) and ‘[t]he first half is followed by a separate, unrelated commercial so that the viewer has to wait for the second half to see what happens to the sufferer’ (see Excedrin Commercial Spot).”

However, it is unclear how the Office Action equates a 15-second pod that is well known in the art as a **single commercial advertisement** to the claimed element “... the **commercial advertisement** is authored to provide a teaser **in a first beginning portion of the commercial advertisement** ...” If the Office Action’s logic is to equate the 15-second commercial spot as the claimed commercial advertisement, then it is clear that the Gales article cannot teach that a commercial advertisement is authored to provide a teaser in a first beginning portion of the commercial advertisement because the Gales article teaches away from the claimed feature by teaching that a 15-second commercial advertisement is displayed in an untouched form. The Gales article does not teach or disclose making any modifications of the 15-second commercial advertisement. The fact that there is a corresponding 15-second commercial advertisement played at a later time in the set of commercial advertisements does not mean that the first 15-second commercial advertisement is authored to provide a teaser in a first beginning portion of the commercial advertisement as claimed in Claim 19.

Docket No.: 60097-0195

The Gales article in paragraph 7, specifically discloses that the 15-second commercial advertisement is, indeed, a standalone commercial advertisement and can be separated by a second related 15-second commercial advertisement by many months.

Assuming, *arguendo*, that the Office Action equates the two 15-second commercial advertisements as the claimed commercial advertisement, this incorrect combination of two separate commercial advertisements cannot teach the claimed feature where the commercial advertisement is authored to provide a teaser in a first beginning portion of the commercial advertisement because there is no teaching in the Gales article that the first 15-second commercial can be modified to provide a teaser in a first beginning portion of the commercial advertisement. If the Office Action's intention is to say that two 15-second commercial advertisements that are separated by time are equal to one commercial advertisement, then that is contrary to what is well known in the art because a commercial advertisement (i.e., "pod" as referred by Gales) is considered a single, contiguous segment. Further, the advertiser schedules (and pays for) each 15-second commercial spot for different time slots which means that the two 15-second commercial advertisements are separate commercial advertisements and cannot be considered as a single commercial advertisement.

Therefore the Gales article does not contemplate a process where the commercial advertisement is authored to provide a teaser in a first beginning portion of the commercial advertisement to entice a viewer to watch commercials during a commercial break before the viewer causes the DVR to skip through the commercial break as claimed in Claim 19.

Furthermore, the Gales article teaches away from the Office Action's reasoning for modifying the Gales and Audi combination with the Geer DVR by teaching that it is

Docket No.: 60097-0195

doubted that bookending is effective against zapping. Therefore, the Gales article teaches away from combining Geer with the Gales and Audi articles as suggested by the Office Action. Geer itself teaches away from combining Geer with the Gales and Audi articles as suggested by the Office Action because Geer teaches away from viewing commercials. Geer explains that "commercials" are "tedious content" which "may be skipped to advantage." (Geer 3:35-36). Geer further teaches that a user "may command the DVR to skip commercials until the time of the portion being viewed merges with real time." (Geer 4:21-25). In fact, a major portion of Geer is devoted to teaching the skipping of commercials (9:45-10:41).

Additionally, the Larry Collins article: "... Media People See Pros and Cons," in paragraphs appearing on the same page as the Gales Article, teaches that the bookending method disclosed in the Gales Articles actually has a negative effect upon other commercials in a commercial break. Therefore, the Collins article, appearing on the same page as the Gales article, teaches away from the Office Action's reasoning for combining Geer with the Gales and Audi articles.

Therefore, the Gales Article in view of the Audi article in further view of Geer does not teach or disclose the invention as claimed.

Claim 19 is in allowable condition. Claims 20-22 are dependent upon independent Claim 19. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

### III CLAIM REJECTIONS – 35 U.S.C. § 103

The Office Action reject Claims 3, 14-15, 18 and 23-28 under 35 U.S.C. § 103(a) as being unpatentable over Gales Article: "Creatives find 'Bookends' a Solution to

Docket No.: 60097-0195

Viewer Apathy" (of record) in further view of Automotive News: "Audi Ads focus on technology" (of record), Geer et al. (U.S. 6,788,882 B1) and Balakrishnan et al. (US 2001/0052135 A1). The rejection is respectfully traversed.

The rejection under 35 U.S.C. §103(a) is deemed moot in view of Applicant's comments regarding Claims 1 and 19, above. Claims 3, 14-15, and 18 are dependent upon independent Claim 1. Claims 23-28 are dependent upon independent Claim 19.

Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

#### IV. CLAIM REJECTIONS – 35 U.S.C. § 103

The Office Action rejects Claims 4 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Gales Article: "Creatives find 'Bookends' a Solution to Viewer Apathy." The rejection is respectfully traversed.

Claims 4 and 17 have been amended to clarify the claimed invention and appear as follows:

4. A process for enhancing the viewership of television advertisements in a digital video recorder (DVR) environment, comprising the steps of:
  - designating a beginning portion within a television advertisement;
  - wherein said beginning portion is of a particular length of time;
  - wherein said beginning portion contains more important content designed to get a desired message across to a viewer in the predetermined length of time;
  - and
  - wherein an advertiser is charged a particular fee by a content provider for placing the television advertisement at a beginning of a commercial break.

Docket No.: 60097-0195

17. A process for enhancing the viewership of television advertisements in a digital video recorder (DVR) environment, comprising the steps of:

- designating an end portion within a television advertisement;
- wherein said end portion is of a particular length of time;
- wherein said end portion contains more important content designed to get a desired message across to a viewer in the particular length of time; and
- wherein an advertiser is charged a particular fee by a content provider for placing the television advertisement at the end of a commercial break.

Claims 4 and 17 cite designating a beginning portion **within** a television advertisement and wherein said beginning portion is of a particular length of time, and designating an end portion **within** a television advertisement and wherein said end portion is of a particular length of time, respectively. The Gales article does not teach or disclose such features. The Office Action had stated that the Gales article discloses splitting an advertisement into two 15 second spots. However, the claimed features designate a beginning or ending portion **within** the television advertisement. The Gales article deals with creating two separate and distinct 15-second commercials and does not contemplate the designation of a beginning portion **within** a television advertisement and wherein said beginning portion is of a particular length of time, as in the case of Claim 4, nor does it contemplate the designation of an end portion **within** a television advertisement and wherein said end portion is of a particular length of time, as in the case of Claim 17.

Therefore, the Gales article does not contemplate wherein said beginning portion contains more important content designed to get a desired message across to a viewer in



Docket No.: 60097-0195

the predetermined length of time and wherein said end portion contains more important content designed to get a desired message across to a viewer in the particular length of time as cited in Claims 4 and 17.

The Office Action takes Official Notice “that it is notoriously well known in the art to charge advertisers particular fees in relation to the duration and position of an advertisement in a commercial break.” Applicant is unaware of any prior art teaching “to charge advertisers particular fees in relation to the duration and position of an advertisement in a commercial break.” In accordance with MPEP § 2144.03, Applicant respectfully traverses this Official Notice and requests the production of documentary evidence indicating such a teaching.

Furthermore, the Official Notice is improper because Claim 4 does not pertain to charging advertisers particular fees in relation to the duration and position of an advertisement in a commercial break. Rather, Claim 4 pertains to charging a fee for a specific type of advertisement “wherein said beginning portion contains more important content” placed specifically “at the beginning of a commercial break.” To Applicant’s knowledge, charging a fee for this specific arrangement is unknown within the art.

Furthermore, the Official Notice is improper because Claim 17 does not pertain to charging advertisers particular fees in relation to the duration and position of an advertisement in a commercial break. Rather, Claim 17 pertains to charging a fee for a specific type of advertisement “wherein said end portion contains more important content” placed specifically “at the end of a commercial break.” To Applicant’s knowledge, charging a fee for this specific arrangement is unknown within the art. In particular, charging a fee for an advertisement placed *at the end* of a commercial break would not have been obvious.

Docket No.: 60097-0195

Therefore, the Gales Article does not teach or disclose the invention as recited in Claims 4 and 17.

Claims 4 and 17 are in allowable condition. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

V. CLAIM REJECTIONS – 35 U.S.C. § 103

The Office Action rejects Claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Balakrishnan et al. (US 2001/0052135 A1) in further view of Geer et al. (US 6,788,882 B1). The rejection is respectfully traversed.

Neither Balakrishnan nor Geer teaches or discloses a system wherein the DVR pauses playback of the program segment after displaying the menu as claimed in Claim 16. The Office Action suggests that “pauses playback of the program segment after displaying the menu” is met in Balakrishnan by a menu displayed for a predetermined default period of time. This fails to constitute pausing *playback of the program segment*.

Balakrishnan’s receiver is incapable of pausing playback of the program segment because Balakrishnan pertains to commercials broadcast in real-time over a multiplexed data stream (Balakrishnan Figs. 1-3, [0026]). In Balakrishnan, the program segment is never actually paused. Instead, the menu (i.e. multimedia hotspots) is a continuation of the live broadcast over the real-time data stream (Balakrishnan Figs. 1-2, [0006]). When a user fails to choose a hotspot after a predetermined period of default, the receiver simply branches to one of a plurality of live commercials (Balakrishnan [0007]) broadcast within the same data stream (Balakrishnan [0009]). Balakrishnan fails to disclose means for pausing a program broadcast over the data stream.

Docket No.: 60097-0195

For example, suppose Balakrishnan's receiver is displaying program A, a half hour program, which it receives in a real-time broadcast over data stream D. Further suppose Balakrishnan's receiver reaches a commercial break in program A, at which point data stream D broadcasts a menu. Balakrishnan's receiver would be incapable of pausing on this menu for an hour and then resuming playback of program A because data stream D will have long ago finished broadcasting program A. Thus, Balakrishnan fails to disclose pausing playback of the program segment.

Nor is there any suggestion or motivation to combine Balakrishnan's menu of commercials with Geer's DVR. Geer, in fact, teaches away from viewing commercials. Geer explains that "commercials" are "tedious content" which "may be skipped to advantage." (Geer 3:35-36). Geer further teaches that a user "may command the DVR to skip commercials until the time of the portion being viewed merges with real time." (Geer 4:21-25). In fact, a major portion of Geer is devoted to teaching the skipping of commercials (9:45-10:41). Thus, it would not have been obvious to combine Geer with Balakrishnan, which teaches the viewing of commercials.

Furthermore, it would not have been obvious to combine Balakrishnan and Geer because Balakrishnan is incompatible with Geer. Balakrishnan requires a receiver configured to receive a multiplexed data stream broadcast over a single channel (Balakrishnan [0018, 0021]), display a plurality of multimedia hotspots (Balakrishnan [0006]), and "de-multiplex the received multiplexed data stream . . . so that the commercial packets comprising the commercial . . . can be re-assembled and displayed as a continuous picture on the television screen." (Balakrishnan [0023]). These features are absent in Geer, and it is not clear how Geer's device would be capable of such functionality. In fact, Geer's DVR is incapable of displaying the multiple commercials

Docket No.: 60097-0195

contained within Balakrishnan's multiplexed data stream because it achieves DVR functionality by recording a broadcast data stream directly to a video file from which it then displays video. Nowhere does Geer contemplate a video file capable of storing representations of multiple commercials from the same channel.

Therefore, Balakrishnan in further view of Geer does not teach or disclose the invention as claimed.

Claim 16 is in allowable condition. Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

#### VI. CLAIM REJECTIONS – 35 U.S.C. § 103

The Office Action reject Claims 29 under 35 U.S.C. § 103(a) as being unpatentable over Gales Article: "Creatives find 'Bookends' a Solution to Viewer Apathy" (of record) in further view of Automotive News: "Audi Ads focus on technology" (of record), Geer et al. (U.S. 6,788,882 B1 of record), Balakrishnan et al. (US 2001/0052135 A1 of record), and Dimitrova et al. (US 6,100,941 of record).

The rejection under 35 U.S.C. §103(a) is deemed moot in view of Applicant's comments regarding Claim 19, above. Claim 29 is dependent upon independent Claim 19.

Therefore, Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. §103(a).

#### VII. MISCELLANEOUS

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

AUG 17 2006

Docket No.: 60097-0195

Applicant believes that all issues raised in the Office Action have been addressed and that allowance of the pending claims is appropriate. Entry of the amendments herein and further examination on the merits are respectfully requested.

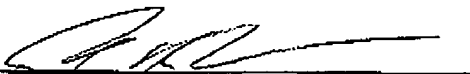
The Examiner is invited to telephone the undersigned at (408) 414-1214 to discuss any issue that may advance prosecution.

No fee is believed to be due specifically in connection with this Reply. To the extent necessary, Applicant petitions for an extension of time under 37 C.F.R. § 1.136. The Commissioner is authorized to charge any fee that may be due in connection with this Reply to our Deposit Account No. 50-1302.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Dated: August 17, 2006

  
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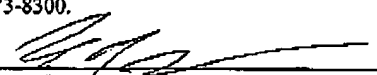
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by

  
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